

REMARKS

Claims 1-9, all the claims pending in the application, stand finally rejected. Claims 1 and 6 are amended. Claim 8 is cancelled. An RCE has been filed in order to ensure entry of the amendment to the claims and prompt consideration of Applicant's arguments.

Claim Rejections – 35 USC 102

Claims 1-4 and 6-9 are rejected under 35 USC 102 as being anticipated by Saito et al (6,782,717). This rejection is traversed for at least the following reasons.

First, as to claim 8, the rejection is moot in view of the cancellation of the claim.

Second, as to independent claims 1 and 6, these claims have been amended to incorporate the limitations of claim 8, which was newly presented in the previous Amendment. As subsequently demonstrated, the limitations of claim 8 are not taught in Saito et al and the claims cannot be anticipated.

In commenting on claim 8 at page 2 of the Office Action, the Examiner advises the Applicants to “look at entire patent.” Applicants have done so and conclude that the limitations in the claim are not found in the prior art.

According to the method as recited in the amended claim 1, present invention is a method of producing a glass substrate for a magnetic disk, comprising several the steps:

- polishing a principal surface of a glass substrate to impart a texture thereon, the texture being formed along a circumference direction of the magnetic disk;
- thereafter supplying a treating liquid onto the principal surface of the glass substrate; and
- pressing a tape against the principal surface of the glass substrate and moving the glass substrate and the tape relative to each other to clean the principal surface,
- whereby disturbance of the texture formed on the principal surface of the glass substrate is reduced.

The claim now provides that a surface roughness of the texture has Rmax of 5 nm or less and Rp of 3 nm or less, Rmax representing a maximum height and Rp representing a maximum peak height, respectively.

According to the method as recited in the amended claim 6, present invention is a method of producing a magnetic disk, comprising the steps of:

- providing a glass substrate; and
- forming at least a magnetic layer on said glass substrate by:
- polishing a principal surface of a glass substrate to impart a texture thereon, the texture being formed along a circumference direction of the magnetic disk;
- thereafter supplying a treating liquid onto the principal surface of the glass substrate; and
- pressing a tape against the principal surface of the glass substrate and moving the glass substrate and the tape relative to each other to clean the principal surface,
- whereby disturbance of the texture formed on the principal surface of the glass substrate is reduced.

The claim now provides that a surface roughness of the texture has Rmax of 5 nm or less and Rp of 3 nm or less, Rmax representing a maximum height and Rp representing a maximum peak height, respectively.

Thus, the present invention as defined by all of the claims has a specific feature, i.e., "a surface roughness of the texture has Rmax of 5 nm or less and Rp of 3 nm or less, Rmax representing a maximum height and Rp representing a maximum peak height, respectively."

For there to be anticipation, each and every limitation must be found expressly or inherently in a single prior art reference. It is basic Patent Law that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131 (8th Edition), Verdegaal Bros. v. Union Oil Co. of Cal., 814 F.2d 628, 631 (Fed. Cir. 1987).

Contrary to the Examiner's observation, Saito et al fails to disclose this feature. Certainly, there is no express teaching of this limitation. If the Examiner believes that such teaching exists, he is respectfully requested to point out where that teaching exists. If the Examiner asserts that the feature is inherent, again, the basis for such inherency should be identified. Applicants respectfully submit that according to the law of inherency, the feature must necessarily follow from the disclosed structure or method in Saito et al. Inherent anticipation requires that the missing descriptive material is "necessarily present," not merely

probably or possibly present, in the prior art. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Applicants respectfully submit that there are a wide spectrum of surface roughness features that could follow from Saito et al, and there is no teaching that the claimed feature would necessarily follow. By contrast, the Applicants have demonstrated in the specification why this limitation is critical. Accordingly, the present invention is not anticipated by Saito, and therefore, is clearly patentable over Saito.

Claim Rejections – 35 USC 102

Claim 5 is rejected under 35 USC 103 as being unpatentable over Saito et al (6,782,717) in view of Shimada (6,632,547). This rejection is traversed for at least the following reasons.

On the basis of the previous argument, parent claim 1 clearly is not anticipated by Saito et al, as it does not teach critical features expressly set forth in the claim. Shimada does not remedy this deficiency, and indeed, the Examiner merely cites Shimada for chemical strengthening of a glass substrate at col. 4, lines 45-65.

Thus, for the reasons already given, amended claim 1 is patentable over the combination of two references, and therefore the dependent claim 5 is also patentable.

Claim 5 is rejected under 35 USC 103 as being unpatentable over Saito et al (6,782,717) in view of Saito et al (2003/0110803). This rejection is traversed for at least the following reasons.

Again, on the basis of the previous argument, parent claim 1 clearly is not anticipated by Saito et al '717, as it does not teach critical features expressly set forth in the claim. Saito et al '803 does not remedy this deficiency. The Examiner merely cites Saito et al for chemical strengthening of a glass substrate in the abstract and “numerous other mentions” throughout the patent. Nonetheless, the reference does not teach the newly added limitations. Indeed, the limitation Rp is not even mentioned while the values of Rmax are well above the limits specified in the claims.

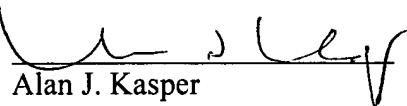
Thus, for the reasons already given, amended claim 1 is patentable over the combination of two references and, therefore, the dependent claim 5 also is patentable.

Amendment Under 37 C.F.R. § 1.114(c)
U.S. Application No. 10/790,111

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Thus, for the reasons already given, amended claim 1 is patentable over the combination of two references, and therefore the dependent claim 5 is also patentable. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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